

REMARKS

I. Introduction

With the cancellation of claim 101 and the addition of new claims 107 to 109, claims 100 and 102 to 109 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 100 to 104 Under 35 U.S.C. § 102(b)

Claims 100 to 104 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,855,312 ("Toledano"). It is respectfully submitted that Toledano does not anticipate these claims for at least the following reasons.

As an initial matter, claim 101 has been canceled herein without prejudice, thereby rendering moot the present rejection with regard to claim 101. Since claim 101 has been canceled herein without prejudice, claim 102 has been amended herein without prejudice to depend from claim 100.

Claim 100 relates to a surgical device for at least one of cutting and stapling a section of tissue. Claim 100 recites a housing for staples, the housing defining a bore and having a distal end; a trocar shaft disposed through the bore of the housing so as to be moveable relative to the housing; and an anvil attachable to the trocar shaft and configured to be moveable relative to the housing by movement of the trocar shaft, wherein at least a portion of the trocar shaft that is extendable distally relative to a clamping face at the distal end of the housing and that is extendable between the clamping face and the anvil is flexible. Although Applicants do not agree with the merits of the present rejection, claim 100 has been amended herein without prejudice to recite that the trocar shaft includes a trocar and ***the anvil includes an anvil sleeve and a trocar receiving slot configured to receive the trocar, the anvil sleeve having a circumferential recess configured to receive a rim that projects radially inwardly from the bore to releasably axially secure the anvil in the bore***. Claims 104 to 106 have been amended herein without prejudice to accord with amended claim 100. Support for these amendments may be found, for example, at page 34, line 6 to page 35, line 2, page 39, lines 11 to page 40, line 10 of the Specification.

It is apparent that the Office Action considers the head portion 11 of Toledano to be anvil as recited in claim 100. See Office Action at page 2 (“wherein the anvil includes an anvil shaft 140 . . . and the trocar receiving slot is defined in an anvil sleeve 16”). However, it is plainly apparent from the description of Toledano that elements 15 and 18, illustrated in Figures 2 and 10a, respectively, each represent an anvil that is attached to the body 26, while the head 11 is attachable to the flexible cable 21, 22. See, e.g., col. 6, line 60 to col. 7, line 6. Since it is clear that the head 11 carries the staple pins, and element 15 or 18 is the anvil against which the staple pins are pressed, there is no apparent basis for the Office Action’s interpretation of element 11 (or the constituent components thereof) as being an anvil attachable to a trocar shaft.

Notwithstanding the foregoing, even is it assumed, arguendo, that the head 11 is an anvil -- which Applicants do not concede -- the head portion does not have any structure that could be considered an anvil as described in claim 100, i.e., an anvil that includes an anvil sleeve and a trocar receiving slot configured to receive a trocar, the anvil sleeve having a circumferential recess configured to receive a rim that projects radially inwardly from a bore to releasably axially secure the anvil in the bore.

It is, of course, “well settled that the burden of establishing a prima facie case of anticipation resides with the [United States] Patent and Trademark Office.” Ex parte Skinner, 2 U.S.P.Q.2d 1788, 1788 to 1789 (Bd. Pat. App. & Inter. 1986). To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, Toledano does not disclose all of the features included in claim 100. As such, it is respectfully submitted that Toledano does not anticipate claim 100 or any claim that depends from claim 100.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 105 and 106 Under 35 U.S.C. § 103(a)

Claims 105 and 106 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Toledano and U.S. Patent No. 6,491,201 (“Whitman”). It is respectfully submitted that the combination of Toledano and Whitman does not render unpatentable these claims for at least the following reasons.

Claims 105 and 106 ultimately depend from claim 100 and therefore include all of the features of claim 100. As set forth above, Toledano does not disclose, or even suggest, all of the features of claim 100. Whitman is not relied upon for disclosing the features of claim 100 not disclosed by Toledano. In this regard, it is respectfully submitted that claims 105 and 106 are patentable over the combination of Toledano and Whitman for at least the same reasons set forth above in support of the patentability of claim 100.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

IV. New Claims 107 to 109

New claims 107 to 109 have been added. It is respectfully submitted that new claims 107 to 109 add no new matter and are fully supported by the present application, including the Specification. Support may be found, for example, at page 42, line 24 to page 48, line 11 of the Specification.

Since claims 107 and 108 ultimately depend from claim 100 and therefore include all of the features of claim 100, it is respectfully submitted that claims 107 and 108 are patentable over the references relied upon for at least the same reasons set forth above in support of the patentability of claim 100.

Claim 109 recites features analogous to the features of claim 100 described above as not being disclosed or suggested by the references relied upon. As such, it is respectfully submitted that claim 109 is patentable over the references relied upon for at least the same reasons set forth above in support of the patentability of claim 100.

V. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Date: June 2, 2009

By: /Clifford A. Ulrich/
Clifford A. Ulrich
Reg. No. 42,194

KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646